

U.S. Patent Application Serial No. **10/524,843**
Response filed October 14, 2008
Reply to OA dated April 14, 2008

REMARKS

By the present amendment, independent claim 1 has been amended to obviate the examiner's objections thereto and/or to further clarify the concepts of the present invention. In particular, claim 1 has been amended to, among other things, incorporate the subject matter on lines 18-22 of page 20 in the originally filed specification with respect to the preferred range for the diester in the subject composition. Dependent claims 25-27 have been added.

It is submitted that these amendments to claim 1 are helpful in distinguishing the subject claims over the cited prior art and do not raise new issues which would require further consideration and/or search. In addition, it is submitted that such amendments place the application in better form for appeal by materially reducing or simplifying the issues for appeal. In view of the above, it is submitted that entry of the above amendments is in order and such is respectfully requested.

In the Office Action, claims 1, 5, 7, 10, 13-18 and 20-23 were rejected under 35 USC § 103(a) as being unpatentable over the patent to Wilson et al in view of the patent to Papay et al. Dependent claims 16-19 again were rejected under 35 USC § 103(a) as being unpatentable over the same patent to Wilson et al in view of the patent to

U.S. Patent Application Serial No. **10/524,843**

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Papay et al further in view of the patent to Cook. Also, claims 20-23 were rejected under 35 USC § 103(a) as being unpatentable over the same patent to Wilson et al in view of the patents to Papay et al and Rudston. Reconsideration of these rejections in view of the above claim amendments, the attached Declaration and the following comments is respectfully requested.

In support of the patentability of the claims as amended, attention is directed to the attached Declaration of Mr. Yasuyuki Kawahara, one of the inventors herein. The submitted Declaration is not as yet executed, but an executed copy will be presented as soon as possible.

Applicants wish to make of record the various telephone interviews with Examiner Goloboy. The above Declaration was submitted by facsimile to Examiner Goloboy on September 12, 2008. In a telephone discussion with Examiner Goloboy on September 18, 2008, it became apparent that applicants' proposal had not been completely communicated to the examiner. The examiner was informed that applicants would be submitting additional information and then the various proposals could be discussed.

On September 19, 2008, a facsimile letter containing various proposals was forwarded to the examiner. At the same time, it was requested that the Examiner telephones the undersigned after he had an opportunity to review each of the proposals.

U.S. Patent Application Serial No. **10/524,843**

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On September 26, 2006, the proposals contained in the facsimile letter were discussed with Examiner Goloboy. At the conclusion of the discussion, the examiner was of the opinion that the proposed Declaration would overcome the art rejections to independent claim 1 if certain amendments were made to the claim. In particular, the examiner noted that the claim now recites a "lubricating oil ...comprising (a) diester...and (b) at least one member... The Declaration submitted shows improved properties for a lubricating oil which basically is totally a diester. However, the manner in which the claim is written allows for the lubricating oil to include only a minuscule amount of the diester. Consequently, the examiner suggested that the claim be amended in some fashion to indicate that the lubricating oil is mostly the diester.

As noted above, the subject matter on lines 18-22 of page 20 describes a preferred range in terms of the amount of the diester. The examiner indicated that the inclusion of the amount of diester as set forth therein would overcome the prior art rejections. It is desired to thank the examiner for the courtesies extended during the interview.

For the reasons stated above, withdrawal of the rejections under 35 U.S.C. § 103(a) and allowance of claims 1, 5, 7-23 and 25-27 as amended over the cited patent publications are respectfully requested.

U.S. Patent Application Serial No. 10/524,843
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In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

KRATZ, QUINTOS & HANSON, LLP



Donald W. Hanson
Attorney for Applicants
Reg. No. 27,133

Atty. Docket No. 050085
Suite 400, 1420 K Street, N.W.
Washington, D.C. 20005
(202) 659-2930
DWH/evb



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PATENT TRADEMARK OFFICE

Enclosure: Declaration of Mr. Yasuyuki Kawahara (unexecuted)